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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,099	12/17/2001	Frank Himmelsbach	5/1310	2352

28501 7590 02/07/2005

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EXAMINER

TRUONG, TAMTHOM NGO

ART UNIT PAPER NUMBER

1624

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/023,099	HIMMELSBACH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tamthom N. Truong	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11-8-04 (RCE).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114.

Applicant's submission filed on 11-08-04 has been entered.

Claims 7-20 have been cancelled.

Claims 1-6 are pending.

### *Double Patenting*

The **nonstatutory double patenting** rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,627,634 B2. Although the

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conflicting claims are not identical, they are not patentably distinct from each other because the genus of formula (I) of US'634 renders obvious the instant formula (I) when formula (I) of US'634 has the following substituents:

- i.  $R_a$  is hydrogen;
- ii.  $R_b$  is equivalent to the instant  $R_a$  which represents benzyl, 1-phenylethyl;
- iii.  $NR_c-CO$  (with  $R_c$  as hydrogen) is equivalent to  $-NH-C(=O)$  of the instant side chain at the 6<sup>th</sup> position;
- iv.  $A$  is equivalent to  $-CH=CH-$  of the instant side chain at the 6<sup>th</sup> position;
- v.  $B$  is equivalent to  $-CH_2-$  of the instant side chain at the 6<sup>th</sup> position;
- vi.  $C$  is equivalent to the instant  $R_b$  when  $C$  represents  $C_{2-4}$ -alkyl- $NR_4$  group.

Formula (I) of US'634 differs from the instant formula (I) by having  $C$  represents more rings or ring systems as a terminal group. However, because both sets of compounds have the same utility (i.e., treating tumors, diseases of respiratory tract, GI, bile duct, gall bladder, etc.), it would have been obvious for one skill in the art to select a subgenus from formula (I) of US'634 having substituents listed above.

3. Claims 1-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 10/016,280. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds of the copending application render obvious the instant formula (I), particularly when formula (I) of the copending application has the following substituents:

- i.  $R_a$  is hydrogen;
- ii.  $R_b$  is equivalent to the instant  $R_a$  which represents benzyl, 1-phenylethyl;
- iii. A-B is equivalent to  $-\text{NH}-\text{C}(=\text{O})-$  of the instant side chain at the 6<sup>th</sup> position;
- iv. C is equivalent to  $-\text{CH}=\text{CH}-$  of the instant side chain at the 6<sup>th</sup> position;
- v. D is equivalent to  $-\text{CH}_2-$  of the instant side chain at the 6<sup>th</sup> position;
- vi. E is equivalent to the instant  $R_b$  when E represents  $\text{C}_{1-4}$ -alkylamino, or di- $(\text{C}_{1-4}\text{-alkyl})$ -amino group.
- vii.  $R_c$  has the same scope as the instant  $R_c$ .

Formula (I) of the copending application differs from the instant formula (I) by not having E representing groups such as: *morpholino*, or a group containing *tetrahydrofuran*, or *tetrahydropyran*. Both sets of compounds have the same utility (i.e, treatment of tumors, diseases of airway, lungs, GI, bile duct, gall bladder, etc.). Therefore, it would have been obvious for one skilled in the art to select the instant formula (I) from the genus of formula (I) of the copending application because one would have expected the same biological activity.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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***Information Disclosure Statement***

4. The information disclosure statement (IDS) submitted on 09-07-04 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 571-272-0676. The examiner can normally be reached on M-F (10:00-6:30).

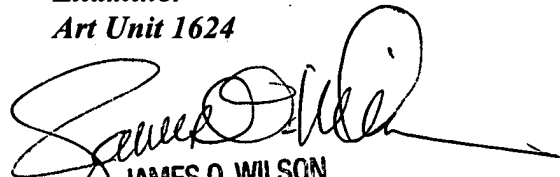
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**Tamthom N. Truong**  
**Examiner**  
**Art Unit 1624**

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12-03-04

  
**JAMES O. WILSON**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**